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In re Application of  
YAMASAKI et al.  
Application No.: 09/647,772  
PCT No.: PCT/JP99/01798  
Int. Filing Date: 04 April 1999  
Priority Date: 05 April 1998  
Attorney Docket No.: 06501-065001  
For: INDOLE DERIVATIVES

DECISION ON  
PAPERS UNDER 37 CFR 1.42

This decision is in response to applicants' "Renewed Submission Under 37 CFR 1.42" filed 10 June 2002. In a decision dated 02 April 2002, applicants' petition filed 11 February 2002 was dismissed because the declaration was not acceptable under 37 CFR 1.42 and 37 CFR 1.497.

BACKGROUND

On 04 April 1999, applicants filed international application PCT/JP99/01798, which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 October 1999. On 20 October 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 05 October 2000.

On 04 October 2000, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and the international application.

On 06 November 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e).

On 04 April 2001, applicant filed the surcharge under 37 CFR 1.492(e) and a declaration and power of attorney executed by Noritsugu Yamasaki; Takafumi Imoto; Hiroshi Kayakiri; Osamu Onomura; Takahiro Hiramura as inventors and Noriko Oku, Chikado Oku, and Tomohito Oku on behalf of deceased inventor, Teruo Oku. In a decision dated 27 July 2001, applicants request under 37 CFR 1.42 was refused.

On 11 February 2002, applicant filed the petition which was refused in a decision dated 02 April 2002.

On 10 June 2002, applicant filed a "Renewed Submission under 37 CFR 1.42."

### DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 10 June 2002 is not executed by Noriko Oku, Chikado Oku, and Tomohito Oku as "representatives" of deceased inventor, Teruo Oku. Additionally, the declaration does not state that Noriko Oku, Chikado Oku, and Tomohito Oku are the "legal" representatives or are all of the heirs of the deceased inventor. Accordingly, the declaration fails to identify the proper relationship under 37 CFR 1.497(b)(2).

Moreover, a review of the declarations filed on 10 June 2002 reveals that the declaration is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration submitted includes two sheets numbered Page 3 of 4. It is unclear if the inventors were presented with only page 3 of 4, in which case the execution would be improper, or they if were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 10 June 2002, which is also improper. (See MPEP 201.03)

The 10 June 2002 petition is not a proper reply to the 02 April 2002 decision. As required in that decision dated 02 April 2002, "the proper response must include an acceptable declaration under 37 CFR 1.497 which has been executed by inventors and either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor." Applicants have not filed the response required by the previous decision. Because the failure to file the proper response does not appear to have been the result of an inadvertent omission, applicants will not be accorded a new time period to correct the deficiencies in the response. Accordingly, the application is hereby held to be abandoned.

### RECOMMENDATION

Applicant may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(b) requesting that the application be revived. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee

required by law for revival of an unintentionally abandoned application (1.17(m)), and (3) a statement that the "delay was unintentional." In this instance, the fee required by law for revival of an unintentionally abandoned application is \$640.

**CONCLUSION**

For the above reasons, the renewed request for status under 37 CFR 1.42 is **REFUSED** and the application is **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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